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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,544	10/25/2000	Michael L. Beacham	426882000200	2119

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EXAMINER

SNAPP, SANDRA S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/696,544

Applicant(s)

BEACHAM ET AL.

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the Amendment filed on 8-16-04. Currently, claims 1-28 are pending in the application.

Specification

The objection to the disclosure and the Abstract has been successfully overcome in the Amendment of 8-16-04 and is herein withdrawn.

Claim Rejections - 35 USC § 112

The rejection of claims 1, 3-6, 8-11 and 15-28 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn in part and maintained in part.

Claims 1, 3-6, 8-11, 15, 17-20 and 22-25 remain indefinite because it is unclear what is meant by a "securities processing system." While the Examiner appreciates the Applicant pointing to the explanation of a system in the specification on page 2, the claims are still vague as to what the Applicant is claiming as their invention. For example, a system could include manual processes, which may not necessarily be included in the claimed invention, and may not satisfy the requirement for technology under 35 U.S.C. 101. The specification, in the discussion of the 'system' itself includes "the many manual processes" as being a part of the 'system.' As such, the system of the present invention needs to be more clearly defined in the claims in order to overcome this rejection. The Examiner suggests amending the claims to include some wording for a computer or a server or processor, etc.

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Claims 15-28 remain indefinite because they lack a clearly defined “system,” see the discussion above.

With regard to the previous rejection of claims 15-28 because it was unclear what was meant by “button.” In view of the Applicant’s response that a button was defined on page 13, lines 15-26 of the specification, the Examiner interprets a “button” in the presently claimed invention to be a hyperlink of the equivalent thereof.

Claim Rejections - 35 USC § 101

The rejection of claims 1-28 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter is herein repeated and made final.

Claims 1-28 are directed to non-statutory subject matter because they lack any reference to technology. The Patent Office has taken the position that claims lacking any reference to technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001)(Unpublished). Although the Bowman case is not precedential, it is cited herein merely for its content and reasoning. The Examiner suggests amending the claims to include some form of technology, such as a computer, etc. in the body of the claim. It is not sufficient to merely put such technology in the preamble.

Claims 15-28 are directed to non-statutory subject matter because they contain functionally descriptive material that is not embedded in any form of tangible medium. The system claimed has language such as “online” and “processing data tool program,” etc. however there is no express computer executable code or computer executable instructions, such are

merely implied. Without such express instructions, there is no nexus between the “system” and the steps it is charged with performing.

Response to Arguments

Applicant's arguments filed 8-16-04 have been fully considered but they are not persuasive. The Applicant argues that under 35 U.S.C. 101 statutory subject matter may be “any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto” and that a process must produce a “useful, concrete and tangible result.” The Examiner agrees. And while the present invention may actually produce a ‘useful, concrete and tangible result’ it must do so by using some form of technology.

Article I, section 8 of the US Constitution affords patentability to those inventions within the “useful arts.” The Patent Office interprets the phrase “useful arts” to mean “technological arts.” Therefore, in order for a claim to be statutory, it must be in the technological arts. In re Musgrave, 167 USPQ 280 (CCPA 1970) and in re Johnston, 183 USPQ 172 (CCPA 1974). In order for the claimed invention to be within the “technological arts” it must satisfy a two prong test. The first prong, is that the invention must ‘produce a useful, concrete and tangible result’ (State Street, 47 USPQ2d 1602) and the second prong is that it must utilize technology in a non-trivial manner (Ex parte Bowman, 61 USPQ2d 1665). The presently claimed invention fails to satisfy the second prong of the test, that is the requirement for technology.

Also, the Examiner appreciates that claims 15-28 are directed to a ‘computer-assisted diagnostic system’ however the Patent Office has taken the position that some form of

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technology must be claimed in the body of the claim to successfully overcome the rejection of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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